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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052684
Party	Defendant NutriScience Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NATURAL SUPPLEMENTS AND REMEDIES, INC.,)	
)	
Petitioner,)	Cancellation No. 92052684
)	
v.)	Mark: VITAENERGY
)	
NUTRISCIENCE CORPORATION,)	Registration Date: May 1, 2007
)	
Registrant.)	
)	

**RESPONSE TO PETITIONER’S MOTION TO STRIKE CERTAIN AFFIRMATIVE
DEFENSES AND MOTION TO DISMISS THIRD COUNTERCLAIM**

Registrant hereby responds to the Motion to Strike Certain Affirmative Defenses and Registrant’s Third Counterclaim.

I. Motion to Strike Affirmative Defenses Should be Denied.

Petitioner’s motion requests that the Board strike certain affirmative defenses.

Registrant has alleged that the petition for cancellation fails to state a claim upon which relief can be granted (paragraph 10); that there is no likelihood of confusion because the marks are not confusingly similar (paragraph 11); that petitioner is guilty of unclean hands (paragraph 12); that Petitioner has abandoned its mark through non-use (paragraph 19); and that petitioner fraudulently procured its registration and further made fraudulent and false statements upon the filing of the renewal (paragraph 21).

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). The primary purpose of pleadings under the Federal Rules of Civil

Procedure is to give fair notice of the claims or defenses asserted, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See, generally, Wright & Miller*, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008).

As to the First Defense, in determining whether to strike Registrant's assertion that Petitioner's pleading fails to state a claim upon which relief can be granted, it is necessary to look at the sufficiency of the pleading. In order to withstand the assertion that a pleading fails to state a claim, a plaintiff must allege such facts that would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and TBMP § 503.02 (2d. ed. rev. 2004). Here, the Petition is not legally sufficient and Petitioner's motion to strike Registrant's first affirmative defense should be denied.

Registrant's ninth and eleventh affirmative defenses assert, respectively, that Petitioner's mark has been abandoned and that Petitioner committed fraud in both the procurement and renewal of the registration. These affirmative defenses, which involve an absence of proprietary rights in an alleged mark, provide Petitioner with notice of Registrant's position with respect to

Petitioner's claim of priority and, thus, function to amplify Registrant's denial of Petitioner's claim of likelihood of confusion and do not prejudice Petitioner. In view thereof, Petitioner's motion to strike Registrant's ninth and eleventh affirmative defenses should be denied.

II. Motion to Strike Third Counterclaim

Again, motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

There is simply no basis whatsoever to strike the Third Counterclaim.

First, the third counterclaim is quite clear as to what is being alleged and the fraud that appears to have been committed during the renewal process. The records for Registration No. 2440741, on their face, appear to show that, instead of providing new specimens, Petitioner's counsel simply submitted old specimens that were not "current." A §8 affidavit must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. 15 U.S.C. §1058(b); 37 C.F.R. §2.161(g). The records of the USPTO confirm a "current" specimen was not provided as required. This counterclaim directly addresses that issue and outlines the facts that clearly support the Registrant's claim.

Second, Petitioner suggests that because the specimens it submitted had to have been reviewed and approved by an examining attorney that review should be respected and is not capable of review by the Board. However, this statement overlooks the fact that a renewal application is not reviewed by an examining attorney. Moreover, when someone has intentionally deceived the trademark office by stating the specimens are current, when in fact they are ten years old and were the same specimens submitted previously, the Board and the

trademark office are not bound any prior review. The trademark office presumes that people are telling the truth. When it can be proven otherwise, one cannot claim that prior false statements should not be considered because they did not get caught the first time.

Third, the specimens do not show use as a service mark, but either as a tradename or on products. Therefore, the specimen did not show, as alleged by Petitioner in the filing of the renewal application, the use of the mark in a manner that would be perceived by potential purchasers as identifying the Petitioner's services and indicating their source. A service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the registration. In the counterclaim, in detail, Registrant, has shown based on the record alone, and is entitled to further prove through further evidence, the acts of fraud that were undertaken to maintain Registration No. 2440741.

In direct contradiction to what Petitioner has claimed, this is a case where the Petitioner has misstated the truth to the USPTO which would allowed a proper determination of the specimens. The USPTO does not have to look outside the specimens to try and determine if the Petitioner, at the time of filing the renewal application was somehow using the mark in ways other than those that were supplied to the USPTO. If the USPTO had been told that the specimens were not current and were not in use at the time of the renewal filing, it would have rejected the renewal application.

A current specimen is at the heart and core of a renewal filing. If one does not have a current specimen, the USPTO provides for the possibility of showing excusable nonuse. That is not the option which Petitioner chose. The rules simply do not allow one to make a statement that use is current by providing evidence that is over ten years old. The fact is clear that Petitioner did not follow the rules and that flaw is reflected right in the record itself.

III. Motion to Strike Paragraphs 15 and 24 of Registrant's Second Counterclaim

Petitioner claims that certain allegations in the Second Counterclaim are immaterial and should be stricken.

Paragraph 15 states that the specimens which were submitted do not support use as a service mark because they were in fact labels on goods, not proper service mark specimens. This issue goes to the issue of whether Petitioner has ever used the mark for services at all and whether Petitioner committed fraud when it filed both of its Section 8 Declarations.

Paragraph 24 is clear on its face as to the allegations made therein. Paragraph 24 outlines in detail the basis for the fraud claims and claims of abandonment. If the mark was not in use when the first Section 8 was filed for certain items, then a false declaration was made as to such Declaration. The filing of a false declaration would constitute fraud which could and should result in the cancellation of Petitioner's registration.

Neither of these paragraphs should be stricken.

IV. Summary

If the Board grants the motion in whole or part, Registrant requests time to file an amended answer to address any insufficient defenses.

Respectfully submitted,

Dated: October 18, 2010

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CERTIFICATE OF ELECTRONIC TRANSMISSION

Date: October 18, 2010

I hereby certify that this paper is being transmitted electronically to the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, on the date indicated above, through the ESTTA electronic filing system at the web site <http://estta.uspto.gov>.


Kurt Koenig

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing “**RESPONSE TO PETITIONER’S MOTION TO STRIKE CERTAIN AFFIRMATIVE DEFENSES AND MOTION TO DISMISS THIRD COUNTERCLAIM**” was served on October 18, 2010 by first-class mail, postage prepaid, to Respondent’s counsel addressed as follows:

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